

## **REMARKS**

The Restriction Requirement mailed March 18, 2004 has been received and carefully considered. Reconsideration of the Restriction is requested in light of the following remarks.

### **I. Amendments to the Claims**

In light of the Restriction Requirement, claims 17-28 and 32-33 have been amended and new claims 59-95 have been added, drawn to lenses and optical systems. Claims 17-28 have been amended to clarify that Applicants properly claim a system and to avoid any narrow interpretation relating to use of the term "apparatus." Support for all of the amendments is found at least at pages 6-7, 12-16 and throughout the specification as originally filed.

Additionally, claims 13-15 and 37-58 have been deleted without prejudice. Applicants reserve the right to file one or divisional applications directed to the subject matter of the cancelled claims.

### **II. Restriction Requirement**

The claims, as grouped by the Examiner, appear as follows:

- I. Claims 1-12, 16-27, drawn to a spectacle lens or optical apparatus, classified in class 351, subclass 159.
- II. Claims 13-15, drawn to a method for producing a spectacle lens, classified in class 351, subclass 205.
- III. Claims 28-36 and 43-46, drawn to an optical measuring system, classified in class 351, subclass 205.
- IV. Claims 37-42, 51-58. Claims 37-38 and 51-54 are drawn to a method for examining a patient's eye, classified in class 351, subclass 246. Claims 39-42 and 55-58 are said

to be grouped in Group IV because they could be searched with the rest of the claims of Group IV without providing an undue burden on the examiner.

V. Claims 47-50, drawn to a method for correcting a patient's vision, classified in class 351, subclass 246.

Applicants respectfully traverse the Restriction Requirement.

The Examiner states that the inventions are distinct, each from the other because Inventions in Group II and Group I are said to be related as process of making and product made in which the product can be made by a materially different process. Inventions in Group III and I are said to be related as combination and subcombination in which the claimed combination does not require the particulars of the subcombination and the subcombination has separate utility. Inventions in Group II and Group III are said to be related as process of making and products made in which the product can be made by a materially different process.

Inventions in Groups I and IV, Groups III and IV, Groups I and V, and Groups III and V are all said to be related as product and process of use in which the process for using the product can be practiced with another materially different product.

Under the patent statute, 35 U.S.C. § 121, an application may be properly required to be restricted to one of two or more claimed inventions, only if they are able to support separate patents and they are either independent or distinct. 37 C.F.R. § 1.141; MPEP 803. However, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions. MPEP 803.

Applicants submit that the claims of the designated groups have not necessarily acquired a separate status in the art for examination purposes, notwithstanding possible different art

classifications which may have been artificially assigned thereto in the Patent Office. Art very relevant to the patentability of one group might logically be found in the art classes assigned to one or all of the other claim groups. The classification cited in support of the restriction requirement is merely used for cataloging purposes and is not conclusive of the propriety of such a requirement.

Applicants assert that the claims of Groups I and III in particular are not wholly unrelated. For example, all of the claims of Group I provide the measurement or correction of non-conventional refractive error measured through the use of some type of wave-front analysis. These limitations are also found in all of the claims pending in Group III, as well as new claims 67-70 which depend from the claims grouped by the Examiner in Group III.

In light of the foregoing, Applicants respectfully request the Examiner reconsider the Restriction Requirement.

Notwithstanding the above, in order to comply with the Restriction Requirement, Applicants elect with traverse the claims of Group I. In electing Group I, Applicants note that new claims 59-66 all depend from claims grouped by the Examiner in Group I and that new claims 71-95 are all directed to a lens or optical system as are the claims of Group I. Therefore, Applicants respectfully submit that claims 59-66 and 71-95 should also be examined along with the claims of Group I.

The Examiner has further indicated that if the claims of Group I are elected, that Applicants must provisionally elect a single claimed species. It is asserted by the Examiner that claims 1-12, 16 and 17-27 are each directed to three distinct species. Applicants note that each of claims 1-12, 16, 17-27, as well as new claims 59-66 and 71-95 all include the limitation that some kind of non-conventional refractive error is measured or corrected and that a wave-front

analysis is used to determine that correction. For example, adaptive optics, such in claim 16, provide non-conventional refractive error correction and are based on wave-front analysis.

Likewise, the optical system of claim 17 uses a wave-front measurement device to measure refraction properties, which by the nature of a wave-front analysis includes non-conventional refractive error if a patient has that type of refractive error. Therefore, Applicants respectfully submit that the alleged species all have a common feature and that they could be examined by the Examiner without any undue burden and that the restriction should be withdrawn.

Nevertheless, as Applicants have elected Group I, Applicants provisionally elect claims 1-12 for prosecution. Applicants submit that new claims 59, 71-85 and 88-95 read on the elected species, as all claims require a prescription based on a wave-front analysis of a wearer's eye. Applicants further submit that the spectacle lens of claim 16 (and its dependent claims 60-61) reads on the lens of claim 1 as the adaptive optics of the lens of claim 16 also correct non-conventional refractive error, as does the lens of claim 1.

If the Examiner has any questions regarding the election of the claims of Group I or the elected species, the Examiner is invited to contact Applicants' undersigned representative for a telephone conference to resolve such questions in an expeditious manner.

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Respectfully submitted,



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